

DISCUSSION OF THE AMENDMENT

Claims 1, 3-6, and 8-21 are active in the present application. Claim 12 is presently withdrawn from prosecution. Claims 2 and 7 are canceled claims. Independent Claim 1 is amended herein to include the limitations of Claim 2. The dependent claims are amended in accordance with the amendment to Claim 1. Claims 19-21 are new claims. Support for new Claims 19-20 is found in the previously presented claims. Support for new Claim 21 is found on page 1, lines 12-16.

No new matter is added.

REMARKS

Applicants draw the Office's attention to new Claim 21 which requires that the claimed process include a step of counteracting the cleavage of the polyurethane formed during the process of using the inhibitor. New Claim 21 is further patentable over the prior art relied on by the Office (see arguments below) for the reason that none of the cited prior art discloses or suggests such a step.

The Office is of the opinion that the process of the previously presented claims is anticipated by one or more of Dany (US 3,847,843); Hall (US 4,670,483); and Arlt (WO-00/66643). In the alternate, the Office is of the opinion that the previously presented claims are obvious over the combination of one of the aforementioned references and Kreyenschmidt (DE 10050417). At the outset, Applicants point out that the Dany, Hall and Kreyenschmidt references do not disclose an inhibitor encapsulated in a wax. The rejections of the claims as anticipated by any of Dany, Kreyenschmidt and Hall should therefore be withdrawn.

On page 4 of the January 31 Office Action, it is asserted that Hall discloses a substance that is embedded in a wax. In particular, the Office asserts that Hall discloses a substance embedded in montan wax. Applicants submit that this is not correct. In fact, the substances of Hall are encapsulated in either melamine-formaldehyde resins (column 3, lines 10-32) or epoxide resins (column 3, lines 33-60). There is no disclosure in Hall of any substance that is encapsulated in a wax.

The Office cited to column 8 as support for the assertion that Hall discloses a substance encapsulated in wax. However, the disclosure of column 8 of Hall does not disclose any material encapsulated in wax. In fact, Hall discloses the inclusion of a "wax lubricant" (column 8, line 13), not a substance encapsulated in wax. Further, the substance (i.e., ammonium polyphosphate) that is the encapsulated substance of Hall is described to be

encapsulated in a melamine-formaldehyde resin (column 8, lines 38-42). The Office's assertion that Hall discloses a substance encapsulated in a wax is therefore not correct.

In the alternate to anticipation, the Office asserts that the aforementioned references combined with Kreyenschmidt render the previously presented claims obvious. With respect to Kreyenschmidt, the Office asserts that this reference "discloses that it is known to encapsulate active agent in polyurethane synthesis operations for the purpose of inhibiting the active agent's effects" (see page 5 of the January 31 Office Action).

Applicants submit that those of ordinary skill in the art would have no basis for combining Kreyenschmidt with any of Dany, Hall or Arlt with a reasonable expectation of success. For example, Kreyenschmidt, at best, discloses encapsulating a catalyst. Applicants submit that an encapsulated catalyst is so different from an encapsulated inhibitor such that an encapsulated catalyst and an encapsulated inhibitor are not remotely comparable in any respect. Encapsulating a catalyst will inhibit the catalytic effect of the catalyst (e.g., it will slow down a reaction). Encapsulating an inhibitor will inhibit its inhibitory effect (e.g., it will speed a reaction). The encapsulating of Kreyenschmidt is totally different than the encapsulating of the present claims because it achieves exactly the opposite effect achieved in the present invention. Modifying any of Dany, Hall or Arlt in the manner allegedly suggested by Kreyenschmidt (e.g., to include an encapsulated catalyst) would not lead to the presently claimed invention and thus the rejection should be withdrawn.

A catalyst and an inhibitor are different materials and would be expected by those of ordinary skill in the art to exhibit substantially different properties and chemical reactivities with respect to their ability to catalyze a reaction or inhibit a reaction, respectively. Applicants thus submit that an encapsulated catalyst (e.g., an encapsulated active agent) does not render obvious or suggest an encapsulated inhibitor.

The Office relies on the following logic for supporting the rejection:

Accordingly, it would have been obvious for one having ordinary skill in the art to have encapsulated the active agents of Dany et al. and/or [Arlt] in the manner provided for by [Kreyenschmidt] for the purpose of inhibiting their active effects in order to arrive at the products and processes of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results.

This logic does not make sense. Kreyenschmidt encapsulates a catalyst to inhibit it. The claimed invention encapsulates an inhibitor to lessen its inhibitory effect, exactly opposite Kreyenschmidt's purpose. There is no evidence of record and no common sense argument that would support an argument that the encapsulating of Kreyenschmidt is the same or suggest the encapsulating of the present claims.

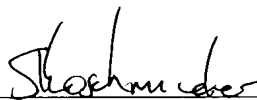
For the reasons discussed above, Applicants submit that the present claims are patentable over the prior art relied on by the Office in the January 31 Office Action and respectfully request allowance of all now-pending claims.

REQUEST FOR REJOINDER

Upon finding the subject matter of Claim 1 patentable, the Office is requested to rejoin and allow Claim 12 which depends from and therefore includes all the limitations of Claim 1.

Respectfully submitted,

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